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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/018,104	02/03/1998	JAMES L. HOBART	PHAN-00100	9278

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EXAMINER

SHAY, DAVID M

ART UNIT PAPER NUMBER

3739

DATE MAILED: 05/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/018164

Applicant(s)

Hobart et al

Examiner

d. shay

Group Art Unit

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—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE → - MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on Amended to March 13, 2002
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-14, 17-24, & 41-49 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-14, 17-24, & 41-49 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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The rejections set forth in the previous Office action are hereby repeated.

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 41-49 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed disclosure is silent on the lasers producing the same wavelength.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2-5, 11-14, 17-23, and 49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 2 and 49 exactly what is to be encompassed by the term "arm feature" is unclear. Claims 11 and 17 are indefinite as the meaning of the term "two or more lasers which are combined in an alternating pattern" is unclear. For the purposes of examination the term will be read as – two or more lasers each producing laser beams--

Claims 11 and 17 are further indefinite because it is unclear how the beams are combined "in an alternating fashion" wherein "a plurality of coagulative laser" pulses are generated and "delivered in sequence to a target area".

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5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 11, and 17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Dwyer et al.

7. Claims 1-3, 6-8, 11-14, 17-19, and 43-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sklar et al in combination with Dew ('969), Anderson et al, Belkin et al and Dwyer et al. Sklar et al teach a laser system including multiple lasers with a graphical interface and teach that it can be used for any type of surgery with any type of laser and that the depth of the laser action can be input and displayed. Dew ('969) teaches the use of a carbon dioxide laser operating at 10.6 microns as a cutting laser in laser system comprised of multiple lasers and teaches that the power of a pulse determines the amount of heat deposited in the tissue. Belkin et al teach that carbon dioxide lasers operating 10.6 microns can be used to heat, rather than cut tissue. Anderson et al teach the way parameters such as absorptivity spot size, and pulse width interrelate to control the amount of energy absorbed by tissue. Dwyer et al teach performing surgery by alternating cutting and coagulation. It would have been obvious to the artisan of ordinary skill to use a carbon dioxide laser as taught by Dew ('969) in the graphical user interface of Sklar et al, since this is to be used with any laser, as taught by Sklar, et al, to also configure the laser to coagulate as taught by Belkin et al, since this would render the device more versatile, at no extra cost and to

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employ the particular laser parameters claimed since these provide no unexpected result, and are within the scope of one having ordinary skill in the art as shown to by Anderson et al to alternate cutting and coagulating pulses, since this enables bloodless surgery as taught by Dwyer et al; employ an articulated<sup>r</sup> arm, since these are notorious in the art for transporting infrared radiation such as that from Carbon dioxide lasers, official notice of which has already<sup>been</sup> taken and to use a galvanometer to alternate the beams, since these are notorious for moving optical components official notice which is hereby taken thus producing a device such as claimed.

8. Claims 4, 5, 9, 10, 20-24 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sklar et al in combination with Dew ('969), Anderson et al, Belkin et al and Dwyer et al as applied to claims 1-3, 6-8 11-14, 17-19, 41, and 43-49 above, and further in view of Assa et al. Assa et al teach a scanning handpiece and the equivalence of carbon dioxide and Erbium YAG lasers. Thus it would have been obvious to the artisan of ordinary skill to employ an handpiece as taught by Assa et al, since this allows more consistency of treatment and to employ an erbium laser, since these are equivalent to the carbon dioxide laser, thus producing a device such as claimed.

9. Applicant asserts that the use of two lasers of the same type will result in the output beam being a single wavelength. The examiner must disagree, noting that Dwyer et al use the same type of laser to produce different wavelengths.

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10. To extent that applicant argues the references teachings, they are argued separately without regard to what the combination would teach one having ordinary skill in the art.

11. Regarding the remarks filed November 16, 2001, the examiner reiterates that Dwyer et al teach the production of two wavelengths with a single laser. Regarding the indefiniteness rejection if the term "arm feature" is intended to refer to an articulated arm, the claim should be amended to reflect this.

Regarding the anticipation rejection, applicant has pointed to nothing which would indicate that the train of laser pulses of Dwyer et al all of which follow a common path regardless of wavelength should not be considered a beam. Regarding the obviousness rejection, the examiner notes that all reference are properly combined with proper motivations specifically set forth.

11. Applicant's arguments filed November 16, 2001 have been fully considered but they are not persuasive. The foregoing due to the above remarks.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to David Shay at telephone number (703) 308-2215.

David Shay:bhw

April 25, 2002



DAVID M. SHAY  
PRIMARY EXAMINER  
GROUP 330